

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REISSUE APPLICATION

Applicants : Youman et al.
Reissue Application No. : 09/313,532 Confirmation No. : 4047
Filed : May 13, 1999
Patent No. : 5,629,733 Issued: May 13, 1997
For : ELECTRONIC TELEVISION PROGRAM GUIDE SCHEDULE
SYSTEM AND METHOD WITH DISPLAY AND SEARCH OF
PROGRAM LISTINGS BY TITLE
Art Unit : 2623
Examiner : Joseph G. Ustaris

New York, New York 10036
June 9, 2008

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicants request review of the rejection of claims 1-55 in the above-identified application. No amendments are being submitted with this Request. This Request is being filed with a Notice of Appeal.

ARGUMENTS

I. Summary

Claims 1-55 are pending in this application. Claims 1-23 are allowed, and claims 24-55 have been rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue is based.

Applicants respectfully submit that the recapture rejection was clearly erroneous. While a limitation added or argued during the original prosecution to overcome an art rejection may not be omitted, the law is clear that such a limitation may be **broadened**. As explained below, claims of the issued patent were amended during prosecution to add a specific means for selecting characters with a remote control. This was the “cycling” feature, where characters are selected by "causing each of said n characters to cycle forward and backward". Applicants' reissue claims 24 and 40 have not omitted the specific mechanism for selecting characters, but rather included a broader expression of the mechanism -- “changing from a first character to a second character using the nonalphanumeric keys” of the remote control. The recapture rejection should be withdrawn.

II. Argument

The law on recapture under § 251 is clear – a reissue claim may **broaden** a limitation added or argued during original prosecution:

[i]t must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001). ***However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine.*** *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

MPEP § 1412.02 (emphasis added).

In parent application No. 08/346,603, claim 1 was rejected in a January 30, 1996 Office Action under 35 U.S.C. § 103(a) as being obvious over Young U.S. Patent No. 5,353,121 or Vogel U.S. Patent No. 5,253,066 and Reed U.S. Patent No. 5,241,671. Young and Vogel describe electronic program guides, but as conceded by the Examiner do not describe searching and displaying program titles. Reed discloses a multimedia database search system for a personal computer that uses a keyboard. In response to the rejection, applicants argued that the invention related to "searching based on alphanumeric characters [...] in a user-friendly manner without cluttering the remote control device with a large number of keys." March 7, 1996 amendment, page 12. Furthermore, applicants argued that the combination of Young or Vogel and Reed did not show or suggest how to select multiple characters using a remote control device, thus the combination did not show or suggest any specific means for selecting characters using a remote control device:

Furthermore, even if the teachings of Reed are applied to either Young or Vogel, because Reed does not disclose how to select multiple characters in a title using only a remote control device, one of ordinary skill in the art would still not be possessed of the invention described and claimed by applicants.

March 7, 1996 amendment, page 14, emphasis added. Thus applicants' argued distinction between claim 1 and the cited references is that the cited references do not provide for specific means by which multiple characters are selected using a remote control device.

To further distinguish applicants' claimed invention from the combination of Young or Vogel and Reed, and as an "example" (March 7, 1996 amendment, page 14, emphasis added), applicants amended claim 1 to provide a specific means by which several characters are input by the user using the user selection means (e.g., the remote control device) - to "cycle forward and backward through a plurality of alphanumeric characters."

In the present reissue application, applicants are not pursuing a claim akin to the claim pending prior to applicants' March 7, 1996 amendment (e.g., a claim with no specific means for selecting multiple characters using a remote control device). Moreover, applicants have not omitted the specific means added during prosecution of the issued patent, or attempted to cover all means for selecting using a remote control. Rather, applicants have broadened the expression of the cycling feature. Cycling requires "changing from a first character to a second character using the nonalphanumeric keys," as recited in claims 24 and 40. The limitation of

claim 24 is simply the "citrus fruit peel" to the "orange peel" of the cycling limitation of claim 1 (See MPEP § 1412.02). Accordingly, applicants' claim 24 has not omitted the "cycling" limitation of claim 1, but rather has expressed it in a broader form, as permitted by law.

The discussion above applies also to independent claim 40, which includes the same specific means limitation as claim 24. Accordingly, applicants submit that independent claims 24 and 40 are not an improper recapture of surrendered subject matter. Applicants respectfully request, therefore, that the rejection of these claims (as well as dependent claims 25-39 and 41-55) under 35 U.S.C. § 251 be withdrawn.

III. Conclusion

For the foregoing reasons, applicants submit this application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

/Paul E. Leblond/

Paul E. Leblond
Registration No. 58,397
Agent for Applicants
Fish & Neave IP Group
Ropes & Gray LLP
Customer No. 75563
1211 Avenue of the Americas
New York, New York 10036-8704
Tel.: (212) 596-9000